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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,275	03/18/2004	Pamela K. Lowenthal	36655-95604	5378

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Cynthia L. Smith, Esq.
21 East Huron #1905
Chicago, IL 60611

EXAMINER

PRONE, JASON D

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,275

Applicant(s)

LOWENTHAL, PAMELA K.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 14-26, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/18/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 29 and 30 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The invention of claim 1 could perform a method incorporating a guide bracket and/or a lever arm.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29 and 30 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

2. Applicant is advised that should claim 1 be found allowable, claim 28 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 27 recites the limitation "wherein the center of the bottom end non-circular cutting surface of the first punch is positioned about two and three quarters inches from a center of the bottom end non-circular cutting surface of the second punch". Page 10, lines 1-3 of paragraph [0029] of the specification discloses "The centers of the bottom end non-circular cutting surfaces 46, 50 of the first and second punches 36, 38, respectively, are preferably spaced two and three-quarters inches apart to align with standard two-prong fastener devices". There is no support for a distance about 2.75 inches only a distance equal to 2.75 inches.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Rall (5,611,254).

In regards to claims 1 and 28, Rall discloses the same invention including a dual hole punch capable of punching holes adapted to receive a two-prong fastener (10) a base plate having an engaging surface for substantially horizontal engagement with the

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work piece (30), a guide bracket having a first portion and a second portion extending from the first portion (34), the first portion of the guide bracket fixedly mounted to a first portion of the engaging surface (Fig. 4), the second portion of the guide bracket extending adjacent to and spaced apart from a second portion of the engaging surface (Fig. 4) to define a horizontal slot having a wall surface extending between the engaging surface and the second portion of the guide bracket (36), the second portion of the guide bracket includes a first and second bore extending through (38), and the first and second bores are perpendicular to the engaging surface (Fig. 5). Rall further disclose, in regards to claim 1, a lever arm pivotally mounted to the guide bracket (40), the lever arm having a first and second bearing surface (44), a first/second punch disposed in the first/second bore (28), the first/second punch having a top end surface and an opposing bottom end non-circular cutting surface (Fig. 11A), the top end surface of the first/second punch engagedly coupled to the first/second bearing surface (Fig. 5), and the first/second punch being operable to perforate the work piece in response to movement of the lever arm towards the base plate (Fig. 5).

In regards to claims 2-5, Rall discloses each of the bottom-end non-circular cutting surfaces of the first and second punches comprise a rectangular cutting surface (Figs. 11 and 11A), an elongated cutting surface (Fig. 11), a D-shaped cutting surface (Fig. 6), and a modified D-shaped cutting surface (Fig. 7).

In regards to claim 6, Rall discloses the engaging surface includes a first and second die (32) and the first/second defining a first/second die aperture configured to receive the bottom end non-circular cutting surface of the first/second punch.

In regards to claim 7, Rall discloses the first bearing surface extending outwardly from a first/second planar sidewall (Fig. 5 sidewall of the lever shown and the opposite sidewall of the lever not shown) of the lever arm to engaging the top end surface of the first/second punch (44).

In regards to claim 8, Rall discloses a first/second upstanding flange mounted to the top of the first portion of the guide bracket proximate to the first/second planar sidewall of the lever arm (Fig. 5 hidden lines above item 42 and the corresponding flange on the other side), the first and second upstanding flanges having aligned apertures (42).

In regards to claim 9, Rall discloses a pivot pin fixedly mounted between the first and second planar sidewalls (42) the pivot pin extending through the apertures for relative movement of the lever arm about the pivot pin (42).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rall in view of Yerkes (2,524,582). Rod discloses the invention but fails to disclose, in regards to claim 10, a first/second resilient member disposed around the first/second punch, a first end of the first/second resilient member coupled to a first/second lip radially disposed in the first/second bore and a second end of the first/second resilient

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member coupled to a radially extending flange disposed proximate to the top end surface of the first/second punch, and the first/second resilient biases the first/second punch away from the base plate. In regards to claim 11, Rall fails to disclose an adjustable guide adapted to position the work piece. In regards to claim 12, Rall fails to disclose a first/second rod assembly adapted to reciprocally move within at least one aperture formed in a first/second side of the base plate, the first/second assembly having at least one reciprocally moveable rod and an angled bracket perpendicularly mounted to a first end of the at least one rod. In regards to claim 13, Rall fails to disclose the at least one rod of the first rod assembly is adapted to interlink with the at least one rod of the second rod assembly, and the linear reciprocal movement of the first rod assembly causes equal linear reciprocal movement of the second rod assembly.

In regards to claim 10, Yerkes teaches a first/second resilient member disposed around the first/second punch (35), a first end of the first/second resilient member coupled to a first/second lip radially disposed in the first/second bore (32) and a second end of the first/second resilient member coupled to a radially extending flange disposed proximate to the top end surface of the first/second punch (34), and the first/second resilient biases the first/second punch away from the base plate (35).

In regards to claim 11, Yerkes teaches an adjustable guide adapted to position the work piece (45).

In regards to claim 12, Yerkes teaches a first/second rod assembly (45) adapted to reciprocally move within at least one aperture formed in a first/second side of the

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base plate (50), the first/second assembly having at least one reciprocally moveable rod (45) and an angled bracket perpendicularly mounted to a first end of the at least one rod (47).

In regards to claim 13, Yerkes teaches the at least one rod of the first rod assembly is adapted to interlink with the at least one rod of the second rod assembly (54), and the linear reciprocal movement of the first rod assembly causes equal linear reciprocal movement of the second rod assembly (54).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Rall with a resilient member and an adjustable guide, as taught by Yerkes, to allow the handle to move to the inoperative state after each punch is completed and to better align the work piece with the punches.

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rall in view of applicant's admitted prior art (aapa).

Rall discloses the invention including a dual hole punch capable of punching holes adapted to receive a two-prong fastener (10) a base plate having an engaging surface for substantially horizontal engagement with the work piece (30), a guide bracket having a first portion and a second portion extending from the first portion (34), the first portion of the guide bracket fixedly mounted to a first portion of the engaging surface (Fig. 4), the second portion of the guide bracket extending adjacent to and spaced apart from a second portion of the engaging surface (Fig. 4) to define a horizontal slot having a wall surface extending between the engaging surface and the second portion of the guide bracket (36), the second portion of the guide bracket

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includes a first and second bore extending through (38), and the first and second bores are perpendicular to the engaging surface (Fig. 5). Rall further disclose, in regards to claim 1, a lever arm pivotally mounted to the guide bracket (40), the lever arm having a first and second bearing surface (44), a first/second punch disposed in the first/second bore (28), the first/second punch having a top end surface and an opposing bottom end non-circular cutting surface (Fig. 11A), the top end surface of the first/second punch engagedly coupled to the first/second bearing surface (Fig. 5), and the first/second punch being operable to perforate the work piece in response to movement of the lever arm towards the base plate (Fig. 5).

However, Rall fails to disclose the center of the bottom end non-circular cutting surface of the first punch is positioned about 2.75 inches from a center of the bottom end non-circular cutting surface of the second punch. In paragraph [0002] on page 2 of applicant's specification, aapa teaches "Hole punch devices having dual punch elements with circular cutting surfaces are used to create dual circular perforations, typically having centers 2.75 inches apart, in a top portion of one or more sheets of paper". Aapa teaches it is old and well known in the art of punches to have the punch centers spaced 2.75 inches apart. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Rall with a spacing of 2.75 inches between the centers of two punches, as taught by aapa, to allow a specific/common area in-between the punches.

Response to Arguments

10. Applicant's arguments filed 20 December 2005 have been fully considered but they are not persuasive. In response to the argument that Rall is not a dual hole punch, Rall is considered to incorporate 2 sets of dual punches. Applicant uses open claim language. Basically, Rall discloses applicant's apparatus plus 2 additional punches. The apparatus disclosed by Rall is perfectly capable of punching holes that can receive a two-prong fastener. The fact that Rall teaches a specific use for the invention is still only an intended use, meaning it is capable of performing other functions. For example, a user could put a sheet to be cut half way into the slot (32) so only the first 2 punches can associate with the sheet to be cut. These two punched holes could be fastened with a two-prong fastener. Since this apparatus is capable of punching only two holes at once, it is a dual-punch.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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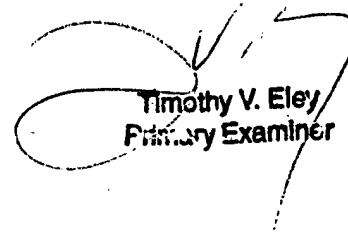
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP
February 14, 2006



Timothy V. Eley
Primary Examiner